

Appl. No. : 09/737,165
Filed : December 14, 2000

REMARKS

Claims 1-10, 21, 29-35, and 41-73 are pending in the present application. Claims 35 and 41-59 are withdrawn from consideration. Claims 72 and 73 have been canceled without prejudice. Claims 6, 7, 60, 65, and 70 have been amended. Reconsideration of the application in view of the foregoing amendments and the following comments is respectfully requested.

In the changes made to the claims by the current amendment, deletions are shown by double brackets (e.g., [[deletions]]), and additions are underlined (e.g., additions).

Amendments to Claims 60, 65, and 70

Applicant has amended Claims 60, 65, and 70 to correct minor typographical errors.

Double Patenting Rejections

(1) U.S. Patent No. 6,001,112

The Examiner rejected Claims 1-3, 5-7, 29, 72, and 73 for obviousness-type double patenting over Claims 1-5, 7, 14-16, and 30 of U.S. Patent No. 6,001,112.

Claims 72 and 73 have been canceled herein, so this rejection is now moot as to these claims. Applicant intends to prosecute these claims in a continuation or other related application.

While the assignee of the present application does not acquiesce in the grounds of this rejection as to the other claims, a terminal disclaimer in accordance with 37 C.F.R. § 1.321(c) is filed herewith in order promptly to resolve this rejection.

Therefore, Applicant respectfully requests that the Examiner withdraw the double patenting rejection of Claims 1-3, 5-7, 29, 72, and 73.

(2) U.S. Patent No. 6,454,779

The Examiner rejected Claims 1-3, 5, 6, 21, and 60 for obviousness-type double patenting over Claims 1-5 and 30 of U.S. Patent No. 6,454,779.

The Examiner may have been mistaken, as there is no Claim 30 in U.S. Patent No. 6,454,779.

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While the assignee of the present application does not acquiesce in the grounds of this rejection, a terminal disclaimer in accordance with 37 C.F.R. § 1.321(c) is filed herewith in order promptly to resolve this rejection.

Applicant respectfully requests, therefore, that the Examiner withdraw the double patenting rejection of Claims 1-3, 5, 6, 21, and 60.

(3) U.S. Patent No. 6,482,217

The Examiner rejected Claims 72 and 73 for obviousness-type double patenting over Claims 66, 70, and 83 of U.S. Patent No. 6,482,217.

As Applicant has canceled Claims 72 and 73 herein, this rejection is now moot. Applicant intends to prosecute these claims in a continuation or other related application.

Claim Rejections Under 35 U.S.C. § 112

The Examiner rejected Claims 6 and 7 under 35 U.S.C. § 112, second paragraph, as being indefinite for lacking antecedent basis for the limitation, “the rotatable tip” in lines 1 and 2.

Applicant has amended Claims 6 and 7 to change “tip” to --element--. Antecedent basis for this amended term is found in Claim 1, line 3.

Claim Rejections Under 35 U.S.C. § 102

The Examiner rejected Claims 1-10, 21, 29-34, and 60-71 under 35 U.S.C. § 102(b) as being anticipated by Sjostrom, et al. (U.S. Patent No. 4,705,038) (“Sjostrom”). The Examiner states that Sjostrom discloses in Figures 1 and 2 an elongate flexible tubular body, a rotatable cutter disposed at the distal end of said tubular body, an aspiration lumen extending through said tubular body, a control disposed on the proximal end of the tubular body, a control disposed on the proximal end of the tubular body, and a sensor and electrical communication with an indicator for indicating resistance to rotation of either the rotatable element or rotatable cutter.

Applicant respectfully traverses this rejection. A rejection under 35 U.S.C. § 102(b) in view of a prior reference can be properly sustained only if that reference discloses each and every element of the claim arranged as in the claim. This Sjostrom fails to do. Each rejected claim is addressed below.

Claims 1-10

Claim 1 recites “an elongate flexible tubular body.” Sjostrom nowhere discloses a tubular body that is flexible. It is well known to those of skill in the art that surgical cutting devices, particularly motorized rotary cutting devices, have been made of metal and that they have not been not flexible.

Furthermore, Sjostrom nowhere discloses “a sensor on the device in electrical communication with an indicator, for indicating resistance to rotation of either the rotatable element or rotatable cutter,” as recited in Claim 1. Rather, the “indicator” of Sjostrom, as described in column 6, lines 38-47, merely “allows front panel indication of which device is in use.” Sjostrom’s indicator is a “decoding circuit selector AS4” that “has only two inputs and therefore depends only on the device [selected].” Depending on the surgical device selected for attachment to the handpiece, this indicator allows an LED “on the panel to light to signal which device is attached. If no device is attached, no LED lights and no power is delivered to the handpiece.”

In contradistinction, the sensor of Claim 1 indicates “resistance to rotation of either the rotatable element or rotatable cutter.” As Sjostrom does not teach or suggest such a limitation, Sjostrom cannot anticipate Claim 1. Furthermore, because Claims 2-10 depend directly from Claim 1, Sjostrom also cannot anticipate Claims 2-10.

Therefore, Applicant respectfully requests that the Examiner withdrawn the rejection of Claims 1-10 under 35 U.S.C. § 102(b).

Claim 21

Claim 21 recites “an elongate flexible tubular body” and “an aspiration lumen” whose cross-sectional area “is at least about 35% of the cross-sectional area of the tubular body.”

Sjostrom nowhere teaches or suggests either of these two limitations. That is, Sjostrom discloses neither a flexible tubular body nor an aspiration lumen that has a cross-sectional area that is at least 35% of the cross-sectional area of the tubular body.

Because neither of these limitations is even suggested by Sjostrom, Sjostrom cannot anticipate Claim 21.

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Therefore, Applicant respectfully requests that the Examiner withdraw the rejection of Claim 21 under 35 U.S.C. § 102(b).

Claims 29-34

Claim 29 recites “an elongate flexible tubular body.” Sjostrom nowhere teaches or suggests a tubular body that is flexible, as discussed *supra* in the arguments concerning Claims 1-10.

Because Sjostrom does not disclose all of the elements of Claim 29, Sjostrom cannot anticipate Claim 29. Furthermore, because Claims 30-34 depend either directly or indirectly from Claim 29, Sjostrom also cannot anticipate Claims 30-34. In addition, Sjostrom does not anticipate Claims 30-34 because Sjostrom does not disclose the additional elements contained in each of Claims 30-34.

Applicant therefore respectfully requests that the Examiner withdraw the rejection of Claims 29-34 under 35 U.S.C. § 102(b).

Claims 60-64

Amended Claim 60 recites “an elongate flexible tubular body” and “a sensor on the device in electrical communication with a motor control circuit, wherein the motor control circuit is capable of receiving a signal from the sensor for indicating an operating condition based upon resistance to rotation of either the rotatable element or rotatable cutter and wherein the motor control circuit is capable of disengaging the motor rotation from the cutter in the event the operation condition indicates an overload condition.”

Sjostrom nowhere discloses either of the two aforementioned elements. That is, Sjostrom neither teaches nor suggests either a flexible tubular body or a sensor as recited in Claim 60.

Thus, because Sjostrom does not disclose all of the elements of independent Claim 60, Sjostrom cannot anticipate Claim 60. Furthermore, because Claim 61-64 depend either directly or indirectly from Claim 60, Sjostrom also cannot anticipate Claim 61-64.

Therefore, applicant respectfully requests that the Examiner withdraw the rejection of Claims 60-64 under 35 U.S.C. § 102(b).

Claim 65

Amended Claim 65 recites “a control disposed at the proximal end of the tubular body, the control including a connecting hub, the connecting hub coupling the tubular body to the control such that the tubular body may rotate relative to the control.”

Sjostrom nowhere teaches or suggests a connecting hub coupling a tubular body to a control such that the tubular body may rotate relative to the control. Rather, Sjostrom teaches away from this concept. For example, Sjostrom states at column 5, lines 22-36, that the device of Sjostrom utilizes “two magnetic reed switches (34, 34’) in the handpiece 10” that “are controlled by the attached device.” These magnetic switches allow indication of the type of surgical device that is assembled with the handpiece. For example, Sjostrom states at column 5, lines 28-36, “Similarly, assembly of device 14, having magnets 36, 36’, with the handpiece actuates both switches. Assembly of the device 16 with the handpiece causes only switch 36’ to actuate. (If no device is in position, neither switch is actuated.) Thus, the system is able to identify the device which has been assembled with the handpiece.”

If the device of Sjostrom were configured such that “the tubular body may rotate relative to the control,” as recited in Claim 65, the magnetic reed switch mechanism of Sjostrom would not perform the stated function of indicating the type of device assembled with the handpiece.

Thus, because Sjostrom nowhere discloses all of the elements of, and in fact teaches away from, Claim 65, Sjostrom cannot anticipate Claim 65. Furthermore, because Claim 66 and 67 depend directly or indirectly from Claim 65, Sjostrom cannot anticipate these claims either.

Claim 68

Claim 68 recites a “cutter” and “an elongated tubular body connecting the cutter to a control,” and that the cutter is “capable of axial displacement relative to the control.”

Sjostrom nowhere teaches or suggests any cutter that is capable of axial displacement relative to a control.

Therefore, because Sjostrom does not disclose all of the elements of Claim 68, Sjostrom cannot anticipate Claim 68. Moreover, Claims 69-71 depend directly from Claim 68, so Sjostrom cannot anticipate any of Claims 69-71.

Applicant therefore respectfully requests that the Examiner withdraw the rejection of Claims 68-71 under 35 U.S.C. § 102(b).

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CONCLUSION

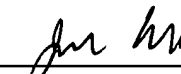
In view of the foregoing amendments and comments, it is respectfully submitted that the present application is fully in condition for allowance, and such action is earnestly solicited. If any questions remain, however, the Examiner is cordially invited to contact the undersigned attorney so that any such matters may be promptly resolved.

Please charge any additional fees or credit overpayment to Deposit Account No. 11-1410.

Respectfully submitted,

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